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No. 06-449

In the Supreme Court of the United States

ON DEMAND MACHINE CORPORATION,
Petitioner,

v.

INGRAM INDUSTRIES INC., LIGHTNING SOURCE INC., AND AMAZON.COM, INC.
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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COUNTERSTATEMENT OF THE QUESTION(S) PRESENTED

Where the Constitutional purpose underpinning the Congress' authority to grant patents is "[t]o promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries," the federal statutes implementing that purpose expressly requiring that the patentee provide a written description of his invention "in . . . full, clear, concise and exact terms," and this Court's holdings in an unbroken series of decisions that a patentee is entitled an exclusive right only to the invention so described, did the Court of Appeals exceed its authority in declining to construe the exclusive right of the patentee to be broader and more expansive than the invention he described in his specification?

PARTIES TO THE PROCEEDING

Pursuant to Supreme Court Rule 14.1(b), Respondents state that all parties appear in the caption of the case on the cover page.

RULE 29.6 STATEMENT

Respondents state that all parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by counsel are:

Ingram Industries Inc.: None.

Lightning Source Inc.: Parent corporation is Ingram Industries Inc.

Amazon.com, Inc.: Legg Mason, Inc., a publicly held corporation, owns more than 10% of the company's stock.

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In the Supreme Court of the United States

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Respondents Ingram Industries Inc., Lightning Source Inc., and Amazon.com, Inc. respectfully oppose On Demand Machine Corporation's (hereinafter "ODMC") Petition for a Writ of Certiorari to review the judgment of the United States Court Of Appeals For The Federal Circuit in this case.

SUMMARY OF REASONS TO DENY THE PETITION

The policy of the patent law, as declared by Congress and this Court, always has been to limit the exclusive patent privilege to the invention thus disclosed by the patentee. This restriction on the scope of the privilege conferred is necessary to the Constitutional purpose underlying the patent grant, "To promote the Progress of . . . useful Arts." U.S. CONST. art. I, § 8, cl. 8. Because full disclosure of inventions

is necessary to effectuate the dissemination of new technology and insure that the public will have full enjoyment of an invention upon expiration of the patent, it would defeat the Constitutional purpose to grant patentees exclusive rights that exceed the scope of their disclosures. Thus, even assuming some split in the decisions (which does not exist), Petitioner proffers no reason to justify the abrupt departure from this Court's precedents that would be required by granting exclusive rights to patentees that exceed the scope of their disclosures to the public.

The Petitioner is incorrect in alleging the existence of conflicting decisions by the Court of Appeals for the Federal Circuit; there is no conflict. Petitioner merely distorts and confuses two separate rules of thumb routinely used by the courts below in construing patent claims. Both rules, however, are entirely consistent with the fundamental principle that while a patentee is entitled to an exclusive right to his invention; the exclusive right extends only to the invention that he has described in "full" and "exact" terms in the specification of the patent. 35 U.S.C. § 112. The recent decisions of the Federal Circuit, including the decision below, do not depart from this fundamental principle. Further, viewed in light of this fundamental principle, there is no conflict between the first and second paragraphs of 35 U.S.C. § 112. Thus, there is no occasion or need for this court to invoke its supervisory authority by granting certiorari.

The decision below, while consistent with the foregoing principles, is highly factually dependent on the subject matter disclosed in Petitioner's patent. As the Court of Appeals for the Federal Circuit determined, this patent describes as its invention a specific consumer-operated "book machine" that provides for the immediate printing, binding and delivery to the consumer of a single copy of a book he selects by viewing promotional information concerning available books on a computer screen provided with the

machine. Thus, the claim in issue could not be interpreted to encompass the radically different book printing operations conducted on a "factory basis" by or at the behest of Respondents, especially since those are the very type of operations disclaimed by the patentee in the patent's specification and during prosecution in the United States Patent and Trademark Office ("PTO"). Accordingly, this case is not an apt vehicle for review of the question presented by Petitioner.

COUNTERSTATEMENT OF THE CASE

The only U.S. patent in suit is No. 5,465,213, issued November 7, 1995. Supp. App. Contrary to Petitioner's assertion that the patent "discloses and claims methods for printing books on demand" (Pet. at 2), the patentee in response to prior art cited by the United States Patent and Trademark Office ("PTO") admitted that patentee Ross did not invent printing on demand. Fed. Cir. JA A8392-8406 ("The Patent Owner is not claiming a patent for 'on-demand' printing of books. . . ."). Significantly, Petitioner does not address the alleged invention actually described in the patent.

The '213 patent describes the Ross invention as an all-in-one "book machine" that provides a computer-style display screen for a potential book purchaser (the "customer") to use to review promotional "sales information" concerning each of hundreds of books whose texts are stored in a computer database. After the customer selects a book for purchase, the machine promptly produces a single copy of the selected book by "printing its text . . . on paper pages" at high speed while the customer waits only a "few minutes" for receipt of his book at the "delivery tray" located at one end of the machine. Supp. App., '213 Patent at col. 1-3 ("Summary of the Invention").

Figure 2 of the drawings of the '213 patent, reproduced below, illustrates the book machine with the customer viewing consoles (36) located on the left and the book delivery tray (56) on the right.

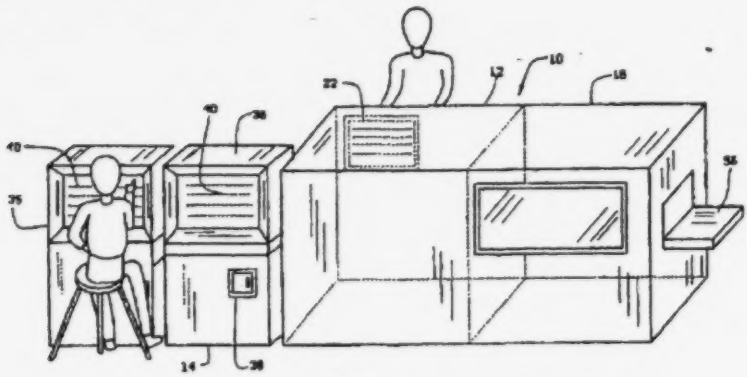

FIG. 2

The specification of the '213 patent contrasts the disclosed invention from "the production of a large quantity of copies of the same book at one time in a factory-setting," stating that

> . . . the present invention involves a computer-based system for the high speed reproduction of a single copy of a selected book, preferably at the consumer point of purchase.

Supp. App., '213 Patent at col. 1, ll. 13-19 ("Background of the Invention").

The specification further emphasizes that the "consumer operated" machine differs from other book printing methods, stating:

> The singular nature of this machine differentiates it from other general purpose machines of a similar kind which require routine adjustment and intervention. Other general purpose machines, although capable of document production are not

> specifically designed to be consumer operated for the on demand, automatic manufacturing of a single book at the point of sale.

Supp. App., '213 Patent at col. 10, ll. 36-43.

Although the '213 patent originally issued with eight claims, claims 1-6 were subsequently cancelled by the PTO in a reexamination proceeding pursuant to 35 U.S.C. §§ 302-307 based on additional prior art not previously considered. Supp. App., '213 Patent, Reexamination Certificate.

In the trial court, the Magistrate Judge construed the meaning and scope of the remaining patent claims, relying heavily on a dictionary-based methodology, now discredited, suggested by the opinion in *Texas Digital Sys., Inc. v. Telegenix, Inc.*[1]

The Court of Appeals below reviewed the district court's construction of various terms of the single patent claim at issue and disagreed with the district court's dictionary-based construction because those constructions departed from the invention described in the '213 patent. App. A at 10a–24a. Because it was essentially undisputed that the book production operations at issue did not embody the "fundamental precept" of the Ross invention that would have been gleaned by readers of ordinary skill in the art – "the immediate printing and binding of a copy of a book, where the customer initiates this activity upon review of promotional information stored in a computer that is provided by the seller" – the Federal Circuit panel concluded

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[1] 308 F.3d 1193 (Fed. Cir. 2002). The dictionary-based approach of *Texas Digital* was subsequently disapproved by the Federal Circuit, sitting *en banc*, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319-24 (Fed. Cir. 2005) (*en banc*) (noting that reliance on dictionary definitions invites expanding patent protection beyond anything invented by the patentee).

that "no reasonable jury could find infringement on the correct claim construction." App. A at 24a-27a.

Rehearing *en banc* was denied by the Federal Circuit on June 20, 2006.

REASONS FOR DENYING THE PETITION

I. This Court's decisions uniformly hold that the patentee's monopoly is limited by the invention described to the public in his specification, and cannot exceed it.

A long and unbroken line of decisions of this Court establish that, for reasons rooted in the Constitution, the scope of a patentee's exclusive right is determined in light of the specification of his patent and may not exceed the scope of the invention he has disclosed to the public in his specification. Thus, Petitioner's sole question has been fully addressed and resolved, and requires no further review or explication in this case.

The Patent Acts of 1790 and 1793 did not require that a patent contain claims defining the protected invention, but left it initially to a group of administrators, and later to the Federal Courts, to determine the scope of the patentee's exclusive right. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 378-79 (1996); *Graham v. John Deere Co.*, 383 U.S. 1, 6-10 (1966). *Hogg v. Emerson*, 47 U.S. 437 (1848) involved a patent issued under the early Acts, and held that the specification, or descriptive "schedule," was an integral part of the patent and properly referred to in order to identify the protected invention or discovery.

> It can hardly be doubted, therefore, that the improvement referred to in the writ and in the letters-patent, with the schedule

> or specification annexed, was in truth one and the same.

Id. at 478-79.

O'Reilly v. Morse, 56 U.S. (15 How.) 62 (1854) considered Samuel Morse's patent for the telegraph, issued under the subsequent Patent Act of 1836. This Court decided that the eighth claim of Morse's patent could not be sustained because it claimed a broader invention than was described in his specification:

> This court has decided, that the specification required by this law is a part of the patent; and that the patent issues for the invention described in the specification.
>
> Now whether the Telegraph is regarded as an art or machine, the manner and process of making or using it must be set forth in exact terms. And in all of these cases it has always been held, that the patent embraces nothing more than the improvement described and claimed as new. . . . The specification of this patentee describes his invention or discovery, and the manner and process of constructing and using it; and his patent, like inventions in the other arts above mentioned, covers nothing more.

Id., 56 U.S. at 118-119, 15 How. at 121-22. In *Bates v. Coe*, 98 U.S. 31 (1878), this Court reaffirmed the principle that the descriptive specification may be referred to "in all cases" "to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims." *Id.* at 38.

In *Snow v. Lake Shore and Michigan Southern Railway Co.*, 121 U.S. 617 (1887), this Court held that the patent claim in question was necessarily limited to a detached

piston and piston-rod as described in the patent's specification.

> On this appeal, it is argued on behalf of the appellants, that this construction of their patent is too narrow; and it is now contended that the detachment of the piston and piston-rod is not an essential part of the description and claim of the invention patented. We cannot, however, but agree with the circuit judge, that the language of the specification limits the first claim to a combination in which the piston and piston-rod are detached from each other.
>
> * * * *
>
> There is nothing in the context to indicate that the patentee contemplated any alternative for the arrangement of the piston and piston-rod. The arrangement of the valves, as shown in the drawings, he declared not to be essential, and explained how they might be otherwise adjusted, and the comparative advantage and disadvantage of those plans; but no such language is used in reference to the connection between the piston and its rod.

Id. at 629-630.

In *McClain v. Ortmayer*, 141 U.S. 419 (1891), this Court observed that "the specification may be referred to to limit the claim," but "can never be made available to expand it." *Id.* at 423-24.

McCarty v. Lehigh Valley Railroad Co., 160 U.S. 110 (1895), heavily relied upon by Petitioner, is not to the contrary, nor even germane to Petitioner's question. *McCarty* held the patent in issue noninfringed, and nothing in the opinion suggests that a patent claim may validly be

broader in scope than the invention described in the specification. *Id.* at 113-20.

In *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47 (1938), this Court again held invalid a patent whose claims were broader than the invention described in the specification. Speaking for the Court, Justice Stone stated:

> The object of the [patent] statute [R.S. 4888] is to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent and "to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not." *Permutit Co. v. Graver Corporation*, 284 U.S. 52, 60. It follows that the patent monopoly does not extend beyond the invention described and explained as the statute requires, *Permutit Co. v. Graver Corporation, supra,* at 57; that it cannot be enlarged by claims in the patent not supported by the description, *Snow v. Lake Shore & M.S. Ry. Co.*, 121 U.S. 617.[2]

Schriber-Schroth, 305 U.S. at 57.

More recent decisions of this Court have not retreated from the principles of these earlier cases, and have continued to require that claimed inventions be construed in light of a patentees' descriptive specification, thereby assuring that patent monopolies are properly limited to inventions disclosed in the manner required by statute.

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[2] The relevant requirements of former R.S. 4888 are now contained in 35 U.S.C. § 112, first paragraph.

Markman, 517 U.S. at 389 (1996) (adverting to "the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole"); *United States v. Adams*, 383 U.S. 39, 49 (1966) ("fundamental that claims are to be construed in light of the specification and both are to be read with a view to ascertaining the invention").

In sum, it is clear from this Court's prior decisions that a patentee may choose to make his patent claim more narrow in scope than the invention described in his specification (*McClain*)[3], but the claim can never be broader than the described invention (*O'Reilly*), and if the claim in fact is broader, then it is invalid (*Schriber-Schroth*). No decision of this Court holds, or even suggests, that a patent claim may be construed to be broader than the invention described. To hold that the claim may be broader would violate both the Constitutional purpose and the patent statutes that continue to require the patentee to file a specification describing his invention in "full, clear, concise and exact" terms. 35 U.S. § 112, ¶ 1. The Constitutional purpose and public policies underlying the central importance of the descriptive specification were emphasized in 1890 by Professor Robinson, stating:

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[3] Patent specifications commonly contain descriptive matter concerning prior art, background matter and other information that is not novel and forms no part of the new invention. *See Merrill v. Yeomans*, 94 U.S. 568, 570 (1876) ("It thus occurs that, in every application, the descriptive part is necessarily largely occupied with what is not new, in order to an [sic] understanding of what is new.") In such cases, where the claims properly focus on the new matter only, it is correct that the claims limit and "define the invention."

Merrill is also consistent with the decisions cited above, in rejecting a construction of the patent that would include a deodorized oil where the specification specifically described only the process for making the oil, not the oil itself, as the invention. *Id.* at 571-73.

> The invention itself must be fully communicated to the public. Of these two obligations the latter is practically the most important. Invention without publication is of comparatively little value to the state, and to reward the inventor, at the public loss, for a discovery which he endeavors for his own advantage to conceal, would be contrary to the entire purpose of the patent privilege. It is the publication, rather than the invention, which promotes the interests of the people; and although invention by some one must necessarily precede publication by any, it has always been the policy of the law to treat the publication as the meritorious act which entitles the inventor to his patent.

1 W. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS, §§ 41-42, pp. 61-62 (1890). Significantly, although Petitioner apparently argues for a new rule that would create patent monopolies broader than the inventions disclosed as the consideration for the patent, Petitioner cites *no* policy or other reason that would justify creating such unmerited windfalls for patentees.

Thus, because this Court's prior decisions fully resolve the sole question presented by Petitioner and because Petitioner fails to suggest any reason in law or policy warranting a departure from the principles stated in those decisions, a writ of certiorari is unwarranted here.

II. The recent Federal Circuit decisions do not depart from the principles announced by this Court; there is no "split".

Consistent with this Court's decisions, the *en banc* Court in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005 (*en banc*) pointed out that,

> The patent system is based on the proposition that claims cover only the invented subject matter. As the Supreme Court has stated, "[i]t seems to us that nothing can be more just and fair, both to the patentee and the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent."

Id. at 1321 (citing *Merrill*, 94 U.S. at 573-74). Contrary to Petitioner's representation, there is no relevant split among the various panels of the Federal Circuit. Petitioner misreads the recent Federal Circuit decisions. All such decisions are consistent with *Phillips*, which emphasizes the importance of the patent's specification in determining the meaning of the claims. 415 F.3d at 1315-16.

Petitioner's argument also confuses two different rules of thumb employed by courts in the construction of patents: first, that patent claims are construed and in light of and consistently with the invention described in the specification and, second, that extraneous details of the inventor's preferred mode (the so-called "preferred embodiment") should not be read into the claims, at least absent some term in the claim whose meaning is made clear by the descriptive specification. The Federal Circuit explained the circumstances in which these rules may properly be applied, and their limits, in *Renishaw PLC v. Marposs Societa Per Azioni*, 158 F.3d 1243, 1248-50 (Fed.

Cir. 1998) (ascertaining the meaning of the claim term "when").

Renishaw explained that when a claim uses a particular word, it is proper to examine the patent specification to determine how the inventor used that word and what meaning it had in the context of the specification, and applying that meaning to the claim does not conflict with the notion that other details not mentioned in the claim (*e.g.*, a type of bolt, the shape of the parts, the size of the motor, etc.) should not be "read into" the claim. *Id.* at 1249. The *Renishaw* court concluded:

> Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors *actually invented* and intended to envelop with the claim. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389, 38 USPQ2d (BNA) 1461, 1470, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996). The construction that stays true to the claim language *and most naturally aligns with the patent's description of the invention* will be, in the end, the correct construction.
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> * * * *
>
> A claim construction is persuasive, not because it follows a certain rule, but because it defines terms *in the context of the whole patent.*

Renishaw, 158 F.3d at 1250 (emphasis supplied).

Similarly, the *en banc* court in *Phillips* explained that

> Much of the time, upon reading the specification in that context, it will become clear whether the patentee is setting out specific examples of the invention to accomplish those goals, or

> whether the patentee instead intends for the claims and the embodiments in the specification to be strictly coextensive. *See SciMed Life Sys.*, 242 F.3d at 1341. The manner in which the patentee uses a term within the specification and claim usually will make the distinction apparent. *See Snow v. Lake Shore & M.S. Ry. Co.*, 121 U.S. 617, 630, 30 L Ed. 1004, 7 S. Ct. 1343, 1887 Dec. Comm'r Pat. 354 (1887) (it was clear from the specification that there was "nothing in the context to indicate that the patentee contemplated any alternative" embodiment to the one presented).

Phillips, 415 F.2d at 1323-24.

The Federal Circuit decisions subsequent to *Phillips* demonstrate no conflict, and are consistent with the principle that patent claims are construed consistently with the patent's specification and may not exceed the invention described therein.[4] Specifically, the subsequent decisions cited by Petitioner, *Honeywell International v. ITT Industries, Inc.*,[5] *Datamize, LLC v. Plumtree Software, Inc.*,[6] *Telep v. The*

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[4] Petitioner also relies on an earlier panel decision, *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313 (Fed. Cir. 2002), but that decision also recognized the fundamental importance of the patent's specification ("[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the best simple guide to the meaning of a disputed term." *Id.* at 1325 (citing *Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). Thus, *Teleflex* is not inconsistent with either *Phillips* or the decisions of this Court.

[5] 452 F.3d 1312 (Fed. Cir. 2006).

[6] 417 F.3d 1342 (Fed. Cir. 2005).

Brinkman Corp.,[7] and *Collegenet, Inc. v. Applyyourself, Inc.*[8] are all based on highly specific fact situations, and none conflicts with *Phillips* or the decisions of this Court. *See Collegenet*, 418 F.3d at 1231 (meaning of claim term must be derived "from their usage and context" in the patent and its specification); *Datamize*, 417 F.3d at 1350-51 (invalidating patent claim where the specification failed to provide an objective standard for claim term "aesthetically pleasing"); *Honeywell*, 452 F.3d at 1318 ("The public is entitled to take the patentee at his word and the word was that the invention is a fuel filter."); *Telep*, 418 F.3d at 1382-83 (holding that claim term "clear plastic" requires a "transparent plastic" in view of guidance supplied by the descriptive specification). None of these decisions even come close to suggesting that a patent claim may validly be broader than the supporting specification.

III. Petitioner's question was not necessarily decided by the decision below, and this case is not an appropriate vehicle for review.

In its Decision, the Court of Appeals below merely followed the teachings of *Renishaw*, *Phillips* and decisions of this Court in construing the meaning of words and terms that appear in Petitioner's patent claims consistently with the inventor's own description of his invention. As the Decision emphasizes, and Petitioner does not dispute, Petitioner did not invent on-demand printing, but only a consumer-operated book machine utilizing a form of that well-known technology. App. A at 26a-27a. There is nothing in the content of the '213 patent to indicate that Ross contemplated

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[7] 418 F.3d 1379 (Fed. Cir. 2005).

[8] 418 F.3d 1225 (Fed. Cir. 2005).

any alternative to his consumer-operated, all-in-one book machine that would justify a broader interpretation of his claims. There is nothing to indicate that "those of ordinary skill," reading the patent, would have interpreted his claims more broadly. Moreover, Petitioner neither alleges nor demonstrates that the Court of Appeals "read in" any detail from his specification apart from the need to understand what the inventor Ross meant by the words in the claim.

Accordingly, resolution of Petitioner's question was not required in order for the Court below to reach its decision in favor of Respondents. This case therefore is not an appropriate vehicle for review of that question.

CONCLUSION

For the foregoing reasons, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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October 24, 2006